

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 6, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sun Mountain Sports, Inc.

Serial No. 75/357,364

Michael J. Hughes for Sun Mountain Sports, Inc.

Stephen R. Fine, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Cissel, Hanak and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 15, 1997, applicant applied to register
the mark "SIGNIA" on the Principal Register for "golf
bags," in Class 28. The basis for the application was
applicant's assertion that it possessed a bona fide
intention to use the mark in commerce in connection with
these goods.

The Examining Attorney refused registration under
Section 2(d) of the Lanham Act on the ground that

applicant's mark, if it were to be used in connection with golf bags, would so resemble the mark "INSIGNIA," which is registered¹ for "golf clubs," that confusion would be likely.

Responsive to the refusal to register, applicant argued that the marks create different commercial impressions because they look different and are spelled differently, and because, whereas the registered mark is a recognizable word with a known meaning, applicant's mark is a "fanciful" term which has no meaning in the English language.

The Examining Attorney was not persuaded by applicant's arguments, and in the second Office Action, he made the refusal to register final. Applicant appealed. Both applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing before the Board.

Our resolution of the issue of likelihood of confusion under Section 2(d) of the Act is based on an analysis of all the probative facts and evidence that are relevant to the factors the Court identified as bearing on the likelihood of confusion issue in *In re E. I. Du Pont & Co.*, 476 F.2d 1357, 177 USPQ 563(CCPA 1973). In any likelihood

¹ Registration No. 1,996,203, issued to Dunlop Slazenger Corp. on August 20, 1996, based on a claim of use since February 6, 1996.

of confusion analysis, two key considerations are the similarities between the marks and similarities between the goods. *Federated Food, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29(CCPA 1976).

Turning first to the goods, in the case at hand, the goods specified in the application are closely related to those set forth in the cited registration. Golf clubs and golf bags are complementary products, and even applicant does not dispute the Examining Attorney's contention that these goods move in the same channels of trade to the same purchasers for use in the same activity. Nor is it disputed that if similar marks are used in connection with these goods, purchasers have reason to assume that the marks indicate that the goods emanate from a single source.

We thus turn to consideration of the marks at issue in this case. Notwithstanding applicant's arguments to the contrary, the mark applicant intends to adopt, "SIGNIA," as applied to golf bags, creates a very similar commercial impression to that created by the use of the mark "INSIGNIA" in connection with golf clubs. These marks are similar in appearance, and because applicant's mark constitutes the last three syllables of the four-syllable registered mark, with only the two-letter prefix "IN" added, these marks would likely be easily mistaken for each

other, especially if they were to be used on the closely related products identified in the application and the cited registration, respectively.

Applicant argues that the absence of a dictionary definition for its mark is a sufficient basis for concluding that the marks would not be confused. We disagree. By leaving off the first two letters of the registered mark, which is a recognized word in our language, applicant has simply allowed the customer to associate its mark with the dictionary word which is registered. As the Examining Attorney points out, this situation is different from the situation where wording which may look or sound similar nevertheless makes a suggestion which is quite different in relation to the goods in question. In the case at hand, while applicant's mark has no apparent meaning, the average purchaser of golf equipment may not know or appreciate that fact. Given the similarity between the mark in the application and the registered mark/recognizable term, such a purchaser might well equate "SIGNIA" with "INSIGNIA."

One final comment on applicant's arguments is in order. The major thrust of applicant's appeal brief appears to be that whether confusion is likely in the case at hand is a close call. Applicant allows that it believes

that is entitled to reversal of the refusal to register, but argues in the alternative that there exists a procedure "which has been grossly underutilized in the US[sic], in recent years. Specifically, applicant suggests that the mark be passed to publication, with the addition that a specific notice of the publication is to be delivered to the owner of the cited registration..." (brief, p.3).

Both the Examining Attorney and this Board are unaware that applicant's suggested alternative procedure has ever been "utilized" in this country. If applicant had obtained a consent agreement from the owner of the cited registration, it surely would have been considered in accordance with legal practice and precedent in this regard. Applicant did not present the Office with such an agreement, however. For the Board to adopt applicant's suggestion would be inconsistent with the Lanham Act, the Trademark Rules of Practice, and past Office practice.

In summary, in this case we are presented with two marks which closely resemble each other and create similar commercial impressions in connection with the goods set forth in the application and the registration, respectively. The goods identified in the cited registration and the goods on which applicant intends to use its mark are closely related, complementary products.

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Under these circumstances, confusion would be likely if applicant were to use the mark it seeks to register on golf bags.

We have no doubt that this would be so, but even if we did have doubt, it would have to be resolved in favor of the registrant and against the applicant, who has a legal duty to select a mark which is totally dissimilar to trademarks already being used in its field. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191(TTAB 1979).

DECISION: The refusal to register is affirmed.

R. F. Cissel

E. W. Hanak

D. E. Bucher
Administrative Trademark Judges
Trademark Trial & Appeal Board

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